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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/688,668	10/17/2003	Gregg L. Shetty	TN-3305	2621
7590 Black & Decker Inc. 701 E. Joppa Road, TW-199 Towson, MD 21286				
05/12/2009				
EXAMINER				
LEE, LAURA MICHELLE				
ART UNIT		PAPER NUMBER		
3724				
MAIL DATE		DELIVERY MODE		
05/12/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/688,668

Applicant(s)

SHEDDY ET AL.

Examiner

LAURA M. LEE

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5, 66-69, 71, 80 and 81 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 66-69, 71, 80 and 81 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/04/2009 has been entered.

Allowable Subject Matter

2. The indicated allowability of claims 66-69 are withdrawn in view of the newly discovered reference(s) to Greenland (U.S. Patent 6,276,990). Rejections based on the newly cited reference(s) follow.

Claim Objections

3. Claim 68 is objected to because of the following informalities: Claim 68 recites, "wherein the motor assembly is pivotably supported by first and second legs. However, as similarly recited in claim 66, last three lines, the first and second legs appear to be of the U-shaped member and not a separate entity. Therefore, as claim 68 already recites a U-shaped member, the legs cannot be recited as their own separate element. They need to be tied back into the U-shaped member, so that the legs are not being

claimed twice. Therefore, claim 68 should be amended to something similar to -- wherein the motor assembly is pivotably supported by first and second legs of the U-shaped member.--

Appropriate correction is required.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3, 66-68, and 80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greenland (U.S. Patent 6,276,990) in view of Lee (6,272,961), Jameson (3,777,792), Weissman (4,885,965), Mayfield (5,063,806), Rueb (5,577,428), Welch (5,906,538), Greenland (6,080,041), and Gorgol et al (6,273,081).

In regards to claims 1, 66, 67, and 80 Greenland discloses a saw (10) comprising: a base formed as a tub (catch basin, 61); a frame assembly (frame 12) disposed on the base (61); a first rail (i.e. track means 51 / extrusions; see col. 3, lines 48-55) disposed on the frame assembly, the first rail having a longitudinal axis (see Figures 1 and 2); a saw assembly (motor assembly 18) disposed on at least one of the base (61) and the frame assembly (12), the saw assembly (18) comprising a support assembly (support arm, 16, and guard 26; see Figure 3), a motor assembly (electric motor 22) pivotally supported (see Figures 3 and 4) by the support assembly (16/26),

the support assembly (16/26) remaining stationary relative to pivotal movement of the motor assembly (22; see Figures 3 and 4) and the motor assembly (22) being pivotable about a pivot axis (pivot axis defined by the radial length of the unnumbered slot in guard 26) substantially parallel to the longitudinal axis (the two axis both extend the length of the assembly 10), and a cutting wheel (cutting blade, 20) driven by the motor assembly (22), the cutting wheel having a plane substantially parallel to the pivot axis (see Figure 3); a table (table, 14) slidably disposed on the first rail (51) so as to be movable relative to the saw assembly (18) in a direction substantially parallel to the longitudinal axis; and a switch (switch 28) electrically connected to the motor assembly (22) and disposed on the support assembly (via the attachment of the motor) above the table and proximate to the motor assembly (22),

wherein the support assembly (16/26) comprises a generally U-shaped member (16) having first and second legs (top and bottom horizontal portions) and the motor assembly (22) pivotally supported by the first and second legs via guard 26.

Greenland does not disclose that the location of the switch is such that, when the motor assembly is pivoted about the pivot axis, the support assembly and the switch remain stationary relative to the pivotal movement of the motor assembly (claim 1), nor that the switch is disposed on the generally U-shaped member (claims 66,67,80) . However, attention is also directed to the Lee, Jameson, Weissman, Mayfield, Rueb, Welch, Greenland, and Gorgol et al. references. These references are cited as cumulative evidence that it is well known in the art to locate the power switch for a cutting tool almost anywhere on a saw. Thus, even though the specific location of the

switch that Applicant is claiming is not specifically taught, the indication from the prior art is that the location of the switch would have been an obvious matter of design choice dependent on the suitability of that location for whatever desired reason, such as dexterity, eye coordination, or standing position of the operator, ease of manufacturing, or position of the work piece and/or product. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to have provided a switch on the saw as claimed, such as on the supporting arm, 16, as suggested by Lee, Jameson, Weissman, Mayfield, Rueb, Welch, Greenland, and Gorgol et al. on the Greenland device in order to accommodate dexterity, eye coordination, or standing position of the operator, ease of manufacturing, or position of the workpiece and/or product.

In addition, it is also noted that it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the switch in an alternative location in order to accommodate dexterity, eye coordination, or standing position of the operator, ease of manufacturing, or position of the work piece and/or product since it has been held the shifting of parts to different positions is a known variable. *In re Japikse*, 86 USPQ 70 (CCPA 1950).

In regards to claim 2, the modified device of Greenland discloses wherein the first rail (51) has a first end, and the table (14) is movable beyond the first end (see Figures 1 and 2).

In regards to claim 3, the modified device of Greenland discloses wherein the table (14) is movable beyond the base (61) (see Figures 1 and 2).

In regards to claim 68, the modified device of Greenland discloses wherein the motor assembly (22) is pivotally supported (via guard 26) by the first and second legs (two horizontal sections of 16)

6. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Greenland in view of Fuhrman et al. (U.S. Patent 6,637,424), herein referred to as Fuhrman. The modified device of Greenland discloses that the frame material may be comprised of steel or other rigid high strength materials of similar characteristics, but does not specifically disclose aluminum. However, it is old and well known to interchange steel members with aluminum and vice versa. Attention is also directed to the Greenland tile saw that discloses a similar setup to the Greenland tile saw, except that the frame is formed from aluminum instead of steel. As both steel and aluminum are well known structural elements and as both are known for fabricating the frame, and as aluminum is a strong and cheaply processed and easily malleable material, it would have been obvious to one having ordinary skill in the art at the time the invention was made to constructed the Greenland frame from aluminum instead of steel. Additionally it is noted that since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

In addition, it is also noted that it would have been obvious to one of ordinary skill in the art at the time the invention was made to construct the frame from aluminum as aluminum is also a well known structural material that is generally cheaper than steel,

since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

7. Claim 69 is rejected under 35 U.S.C. 103(a) as being unpatentable over Greenland (U.S. Patent 6,276,990) in view of Lee (6,272,961), Jameson (3,777,792), Weissman (4,885,965), Mayfield (5,063,806), Rueb (5,577,428), Welch (5,906,538), Greenland (6,080,041), and Gorgol et al (6,273,081) and in further view of McCambridge et al. (U. S. Patent 4,350,193), herein referred to as McCambridge, Marcoux et al. (U.S. Patent 3,342,226) Brenta (U.S. Patent 4,105,055), Sanfillipo (U.S. Patent 6,745,803) and Otto (U.S. Patent 5,161,590). The modified device of Greenland discloses the use of an electrical plug mounted to the support member to power the saw from a wall outlet, but not disclose that the end of the plug/cord is instead terminated at an electrical outlet. However, attention is directed to the McCambridge, Marcoux, Brenta, Sanfillip and Otto reference that all discloses work tables with directly incorporated outlets. These references are cited as cumulative evidence that it is well known in the art to utilize an outlet on a worktable such as shown by Greenland instead of directly engaging the power tool with an AC wall outlet. The outlets provide available and convenient electrical power for utilization with a plurality of tools at the same time, such that only a single cord is required to run to the wall outlet, instead of two cords to operate both the pump and the motor of the saw. It similarly would have been obvious to one having ordinary skill in the art to have incorporated an

outlet into the Greenland support instead of the plug as taught by McCambridge, Marcoux, Brenta, Sanfillip and Otto to minimize the number of cords to power the pump and saw motor plugged into a wall outlet or to power additional tool attachments.

8. Claims 71 and 81 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greenland (U.S. Patent 6,276,990) in view of Lee (6,272,961), Jameson (3,777,792), Weissman (4,885,965), Mayfield (5,063,806), Rueb (5,577,428), Welch (5,906,538), Greenland (6,080,041), and Gorgol et al (6,273,081) and in further view of Sigetich et al. (U.S. Patent 4,428,159) The modified device of Greenland discloses the claimed invention except is silent as to the type of switch and therefore does not appear to disclose that the switch comprises a single throw, double pole switch (i.e. a toggle switch) although Greenland does disclose that a second means may be provided to automatically turn on the motor as a tile is moved toward the motor assembly, and also a manual switch 28 may also be provided; see col. 3, lines 25-30. However, as Greenland is silent as to the type of switch, it would be speculative to positively state that Greenland discloses a toggle switch. However, attention is directed to the Sigetich tile saw cutter which utilizes a toggle switch (51) to energize and de-energize the motor 31 and the pump 53 at the same time. As Greenland also incorporates the use of a pump, but is silent as to how the pump and motor are triggered to operate together and as toggle switches are old and well known in the art for providing on/off connections, it would have been obvious to one having ordinary skill in the art to have incorporated a wiring system such that a toggle switch was incorporated (if not already) such that the

coolant pump would operate in sync with the motorization of the saw blade for turning the power on/off.

Response to Arguments

9. Applicant's arguments with respect to claims 1-3, 5, 66-69, 71, and 80-81 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to LAURA M. LEE whose telephone number is (571)272-8339. The examiner can normally be reached on Monday through Friday, 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on (571) 272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Laura M Lee/
Examiner, Art Unit 3724
05/11/2009